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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,816	03/22/2001	Alejandro Wiechers	10003930-1	6165

7590 04/04/2008
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2176

MAIL DATE	DELIVERY MODE
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04/04/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEJANDRO WIECHERS and GUSTAVO M. GUILLEMIN

Appeal 2007-3285
Application 09/816,816
Technology Center 2100

Decided: April 4, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
ALLEN R. MACDONALD, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1, 3, 4, 6-17, and 19-36. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

1 The invention at issue on appeal is a scan reviewing system. Once an operator selects a registration characteristic of a page of a document to be scanned, "[t]he document may be reviewed relative to the selected registration characteristic." (Abs.) Responsive to identifying a page of the document as not possessing the selected registration characteristic, the scan review system may designate that page for review. (*Id.*)

B. ILLUSTRATIVE CLAIM

Claim 23, which further illustrates the invention, follows.

23. A method for providing information corresponding to a scanned document comprising:

enabling selection of a characteristic of a page of the document;

scanning a page of the document;

reviewing the scanned page for the selected characteristic; and

based on the act of reviewing, determining if the scanned page was properly aligned for scanning.

C. REJECTIONS

Claims 23-26 and 30-33 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,466,336 ("Sturgeon").

Claims 1, 3, 4, 6-17, 19-22, 27-29, and 34-36 stand rejected under

35 U.S.C. § 103(a) as obvious over Sturgeon and U.S. Patent No 6,735,335 ("Liu").

II. ISSUE

"Rather than reiterate the positions of the parties *in toto*, we focus on an issue therebetween." *Ex parte Kuruoglu*, No. 2007-0666, 2007 WL 2745820, at *2 (BPAI 2007). The Examiner makes the following first set of findings.

Sturgeon discloses that the document handling system permits the user to input a page designation (e.g., a page number) in a scan job through a user interface (In **Sturgeon** - see Column 8, Lines 15-22) and subsequently determines whether the registration characteristic of the *scanned* page is "*properly aligned*" with the **user-selected** registration characteristic in that the system sets a flag to notify the user that no page number was found for the scanned page (In **Sturgeon** - see Column 8, Line 63 through Column 9, Line 4).

(Ans. 35.) He also makes the following second set of findings:

[T]he claims still read on Sturgeon in that the document handling system detects pages that are not consistently oriented (e.g., upside-down pages) in a scan job and automatically reorients the inconsistently oriented pages using page-rotation software (In **Sturgeon** - see Column 6, Lines 34-53).

(*Id.* 36.) The Appellants make the following arguments:

"Determining if the scanned page was properly aligned for scanning" does not mean determining inconsistencies in the orientation of pages in a scanned document (Sturgeon column 6, lines 37-53) . . . or determining any correspondence for a characteristic of a page of a document other than the

correspondence of alignment. And, Sturgeon clearly does not teach the correspondence of alignment.

(Amended App. Br.¹ 6.) Therefore, the issue is whether the Examiner has shown that Sturgeon determines if a scanned page was properly aligned for scanning.

III. LAW

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim" *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art."

¹ We rely on and refer to the amended Appeal Brief, in lieu of the original Appeal Brief, because the latter was defective. We will not consider the original in deciding this appeal.

In re Bell, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

IV. ANALYSIS

Here, as aforementioned, the Examiner relies on two passages of Sturgeon to disclose determining if a scanned page was properly aligned for scanning. The first passage explains that a "control circuit determines whether page numbers were located in the anticipated or designated regions of the pages. . . ." (Col. 8, ll. 63-65.) The second passage discloses "determin[ing] inconsistencies in the orientation of certain pages of the batch job" (col. 6, ll. 36-37), "e.g., upside-down pages" (Ans. 36.) The Examiner has not persuaded us that the reference's determining whether a page number was located where it was anticipated or designated to be or the reference's determining whether a page is upside-down constitutes determining if the page was properly aligned for scanning as claimed. The Examiner does not allege, let alone show, that the addition of Liu cures the aforementioned deficiency of Sturgeon.

V. CONCLUSION

The absence of determining if a scanned page was properly aligned for scanning negates anticipation. Absent a teaching or suggestion of the same, we are unpersuaded of a case of obviousness.

VI. ORDER

For the aforementioned reasons, we reverse the rejection of claims 23-26 and 30-33 under § 102(e). We likewise reverse the rejection of claims 1, 3, 4, 6-17, 19-22, 27-29, and 34-36 under § 103(a).

REVERSED

clj

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